UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/713,488	11/15/2000	Leon Wong	13768.136.1	3606

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PERKINS COLE LLP/MSFT
P. O. BOX 1247
SEATTLE, WA 98111-1247

EXAMINER
EL CHANTI, HUSSEIN A

ART UNIT	PAPER NUMBER
2157	

DATE MAILED: 02/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	09/713,488	WONG ET AL.
	Examiner	Art Unit	
	Hussein A El-chanti	2157	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _04 October 2004_.

2a)☐ This action is **FINAL.**   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1-30_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1-30_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

1.   This action is responsive to RCE received on Oct. 4, 2004. Claims 1 and 11-14

were amended. Claims 16-30 were newly added. Claims 1-30 are pending examination.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

2.   Claim 16 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite

for failing to particularly point out and distinctly claim the subject matter which applicant

regards as the invention.

Claim 16 recites the limitation "it" in 10th line of the claim. There is insufficient

antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by
> another filed in the United States before the invention by the applicant for patent or (2) a patent
> granted on an application for patent by another filed in the United States before the invention by the
> applicant for patent, except that an international application filed under the treaty defined in section
> 351(a) shall have the effects for purposes of this subsection of an application filed in the United States
> only if the international application designated the United States and was published under Article 21(2)
> of such treaty in the English language.

3.   Claims 1-5, 7-11, 13 are rejected under 35 U.S.C. 102(e) as being anticipated by

Marquette et al., U.S. Patent No. 6,499,053 (referred to hereafter as Marquette).

Marquette teaches the invention explicitly as claimed including a chat system and method where an inviter can send an invitation to an invitee and receive a join message from the invitee (see abstract).

As to claim 1, Marquette teaches in a computer network that includes a plurality of networked computer systems, wherein a sending computer system sends an instant message through a chain of one or more computer systems to a destination computer system, a method of acknowledging delivery of the instant message, wherein the criteria for determining the success or failure of the delivery are user specified, the method comprising the following:

an act of the sending computer system identifying the user specified criteria for returning a successful acknowledgement message corresponding to the instant message to the user (see col. 2 lines 30-40, inviter sends an invitation message to a user and waits for an accept or decline message);

an act of the sending computer system determining whether the user specified criteria for returning a successful acknowledgement message are met (see col. 2 lines 42-45, the user sends an accept message to the inviter as an acknowledgement to the invitation message); and

an act of the sending computer system returning a successful acknowledgment message corresponding to the instant message only if the user specified criteria have been met (see col. 2 lines 42-48, the inviter receives a join message only if the user accepts the invitation).

As to claims 11 and 16, Marquette teaches in a computer network that includes a

plurality of networked computer systems, wherein a sending computer system sends an

instant message through a chain of one or more computer systems to a destination

computer system, a method of acknowledging delivery of the instant message, wherein

the criteria for determining the success or failure of the delivery are user specified, the

method comprising the following:

an act of the sending computer system receiving an acknowledgement message

for the instant message (see col. 2 lines 7-45);

a step for the sending computer system determining whether user specified

criteria for returning a successful acknowledgement message corresponding to the

received acknowledgement message for the instant message are met (see col. 2 lines

7-45); and

an act of the sending computer system returning a successful acknowledgement

message corresponding to the acknowledgement message for the instant message only

if the user specified criteria have been met (see col. 2 lines 7-45).

As to claim 2, Marquette teaches the method of claim 1 wherein the sending

computer system comprises a sending a client computer system associated with the

user (see col. 2 lines 30-45).

As to claim 3, Marquette teaches the method of claim 1 wherein the sending

computer system comprises a sending client computer system associated with the user

(see col. 13 lines 14-50).

As to claims 4 and 17, Marquette teaches the method and medium of claims 3 and 16 respectively, wherein the act of the computer system identifying the user specified criteria for returning a successful acknowledgement message comprises the following:

an act of the sending server computer system receiving a data field representing the user specified criteria with the instant message (see col. 13 lines 14-50); and

an act of the sending server computer system reading the data field to identify the user specified criteria (see col. 13 lines 14-50).

As to claim 5, Marquette teaches the method of claim 1 wherein the act of the computer system identifying the user specified criteria for returning a successful acknowledgment message comprises the following:

an act of reading a data field representing the user specified criteria from a database accessible to the sending computer system (see col. 13 lines 14-50).

As to claims 7 and 13, Marquette teaches the method of claims 1 and 11 respectively wherein the user specified criteria is a "deep or" criteria (see col. 2 lines 27-32, the inviter enters the invitee name in a list of invitees).

As to claims 8 and 14, Marquette teaches the method of claims 1 and 11 wherein the user specified criteria is a "deep or" and "deep and" criteria (see col. 2 lines 27-32).

As to claim 9, Marquette teaches the method of claim 1 wherein the user specified criteria is a "deep and" criteria (see col. 2 lines 27-32).

As to claim 10, Marquette teaches a computer readable medium having computer executable instructions for performing the acts recited in claim 1 (see col. 2 lines 7-45).

As to claim 15, Marquette teaches a computer readable medium having instructions for performing the specific acts and the step recited in claim 11 (see col. 2).

As to claim 18, the computer-readable medium of claim 17 wherein the indicating includes sending a successful acknowledgement message to the client computer system (see col. 2 lines 5-54).

As to claim 19, the computer-readable medium of claim 16 wherein the sending computer system is a client computer system that originates the instant message and the indicating includes notifying a user that the delivery of the instant message was successful (see col. 2 lines 5-54).

As to claim 20, the computer-readable medium of claim 16 wherein the instant message is sent to multiple destination computer systems and the user-specified criterion specifies that the delivery is successful when at least one destination computer system receives the instant message (see col. 2 lines 5-54).

As to claim 21, the computer-readable medium of claim 16 wherein -the instant message is sent to multiple destination computer systems and the user-specified criterion specifies that the delivery is successful when all the destination computer systems receive the instant message (see col. 2 lines 5-54).

As to claim 22, the computer-readable medium of claim 16 wherein the instant message is sent via a chain of one or more computer systems to the destination

computer system and the user-specified criterion specifies that the delivery is

successful when at least one of the computer systems in the chain receives the instant

message (see col. 2 lines 5-54).

As to claim 23, the computer-readable medium of claim 22 wherein the delivery

is successful when the first computer system in the chain receives the instant message

(see col. 2 lines 5-54).

As to claim 24. (New) A sending computer system for determining whether

delivery of an instant message sent via a network was successful, comprising:

a component that sends via the network the instant message to a destination computer

system (see col. 2 lines 5-54);

a component that receives via the network a successful acknowledgement message for

the sent instant message; and

a component that indicates delivery of the instant message was successful when the

successful acknowledgement message satisfies a user-specified criterion for successful

delivery of the instant message (see col. 2 lines 5-54).

As to claim 25, the system of claim 24 wherein the sending computer system

receives the instant message from a client computer system that originated the instant

message and provides the user-specified criterion (see col. 2 lines 5-54).

As to claim 26, the system of claim 25 wherein the component that indicates

delivery of the instant message was successful sends a successful acknowledgement

message to the client computer system (see col. 2 lines 5-54).

As to claim 27, the system of claim 24 wherein the sending computer system is a client computer system that originated the instant message and the component that indicates notifies a user that the delivery of the instant message was successful (see col. 2 lines 5-54).

As to claim 28, the system of claim 24 wherein the instant message is sent to multiple destination computer systems and the user-specified criterion specifies that the delivery is successful when at least one destination computer system receives the instant message (see col. 2 lines 5-54).

As to claim 29, the system of claim 24 wherein the instant message is sent to multiple destination computer system and the user-specified criterion specifies that the delivery is successful when all the destination computer systems receive the instant message (see col. 2 lines 5-54).

As to claim 30, the system of claim 24 wherein the instant message is sent via a chain of one or more computer systems of the network to the destination computer system and the user-specified criterion specifies that the delivery is successful when at least one of the computer systems in the chain receives the instant message (see col. 2 lines 5-54).

Allowable Subject Matter

4.   Claims 6 and 12 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
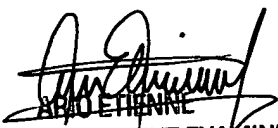
5.   The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure.

6.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Hussein A El-chanti whose telephone number is

(571)272-3999. The examiner can normally be reached on Mon-Fri 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Ario Etienne can be reached on (571)272-4001. The fax phone number for

the organization where this application or proceeding is assigned is 703-872-9306.

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you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

Hussein Elchanti

Feb. 15, 2005

ARIO ETIENNE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100